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Paper No. 7

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OFFICE OF PETITIONS

In re Application of
Alaa F. Alani and Kenneth S. Hunt
Application No. 09/966,327
Filed: September 28, 2001
Atty Docket No. A2-4059 1496.00150
Title: REDUCING THE EFFECT OF
SIMULTANEOUS SWITCHING NOISE

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition filed January 25, 2002, under 37 C.F.R. §1.47(b) for the right to make application for patent on behalf of and as agent for the co-named inventor, Kenneth Steven Hunt, and to revive the application from abandonment. This petition is properly treated as a petition under 37 C.F.R. §1.47(a)¹.

The petition under §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on September 28, 2001, with a declaration identifying Alaa F. Alani and Kenneth S. Hunt as joint inventors. However, the declaration was only executed by inventor Alani. In addition, applicants did not submit the statutory basic filing fee. Accordingly, on October 25, 2001, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application," informing applicants that a declaration with the signature of inventor Hunt, the basic filing fee and the surcharge for late filing under §1.16(e) were required. This Notice set a two-month period for reply, with extensions of time obtainable under §1.136(a).

Preliminarily, petitioner is advised that the instant application has not become abandoned. The filing of the instant reply, including a petition under §1.47; and payment of the basic filing fee, was made timely by an accompanying petition for a one-month extension of time. Given this reply, the application has not become abandoned.

¹ Filing under 37 C.F.R. § 1.47(b) and 35 U.S.C. 118 is permitted only where no inventor is available to make application. In this instance, joint inventor Alani has made application.

Accordingly, the instant petition is **DISMISSED AS MOOT** to the extent that it requests that the instant application be revived from abandonment. Petitioner is further advised that if the application had become abandoned, revival would require not only filing of a petition under §1.47 but also filing of a petition to revive under §1.137(a) or §1.137(b).

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant has authorized that the petition fee be charged to Deposit Account No. 12-2252. The last known address of inventor Hunt is set forth in the petition. However, the petition is not grantable because it is deficient as to requirements (1) and (2).

As to requirement (1), rule 47 applicant has not submitted adequate proof of refusal. Patent Attorney Sandeep Jaggi states that one attempt to present the application papers to non-signing inventor Hunt at his last known address by Federal Express delivery was made. However, on December 12, 2001, the package was returned by Federal Express because the address was incorrect. Applicant's evidence confirms mailing of the application papers, but not receipt by non-signing inventor Hunt. Moreover, applicant has not submitted direct evidence of refusal. Thus, this presentation does not serve as adequate support for a claim of refusal by conduct. A showing that an inventor has not responded to a communication that he has not received is not sufficient to show refusal to join in the application by conduct; on those facts, refusal cannot be inferred.

Under such circumstances, status under §1.47(a) is properly sought with a showing that the non-signing inventor cannot be reached or found, after diligent efforts, to execute the declaration. In this instance, applicant has not shown diligent efforts to locate inventor Hunt. There is no indication that Rule 47 applicant attempted to determine inventor Hunt's forwarding address, and to send the application papers to that address for consideration by inventor Hunt. See MPEP 409.03(d). If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate non-signing inventor Hunt should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of an E-mail or Internet search.

As to requirement (2), the declaration as submitted is not acceptable. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR

1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.

(Emphasis added).

Here, applicants have indicated, by having attorney Jaggi purportedly sign on behalf of non-signing inventor Hunt, that the declaration as submitted is not signed by inventor Alani on behalf of herself and on behalf of joint inventor Hunt. Accordingly, a declaration signed by inventor Alani on behalf of herself and on behalf of inventor Hunt is required. (Her signature should appear on the signature line for herself and for inventor Hunt, noting that she is signing on his behalf.) (Additionally, the second signature block should appear on the same page as the first with the text of the declaration; or at the bottom of the first page, it should be noted that an additional page is attached for signature of additional inventors.)

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.



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